UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,544	02/21/2006	Osamu Kurai	KURA3005/REF	4325

54004 7590 03/19/2009

MUIRHEAD AND SATURNELLI, LLC
200 FRIBERG PARKWAY
SUITE 1001
WESTBOROUGH, MA 01581

EXAMINER	
VO, CECILE H	

ART UNIT	PAPER NUMBER
2169	

MAIL DATE	DELIVERY MODE
03/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,544	02/21/2006	Osamu Kurai	KURA3005/REF	4325

23364 7590 12/23/2008

BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314-1176

EXAMINER	
VO, CECILE H	

ART UNIT	PAPER NUMBER
2169	

MAIL DATE	DELIVERY MODE
12/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/551,544	KURAI ET AL.	
	Examiner	Art Unit	
	CECILE VO	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/2008 has been entered.

2. Claims 1-26 are pending as amended on November 21, 2008, with claims 1, 4, 5, 6, 15, 19 and 23 being independent. Claims 1, 4, 5, 6, 8, 10, 12, 14, 15, 19 and 23-26 are currently amended.

3. New grounds of rejection are provided based on the amendments.

Specification

4. The disclosure is objected to because of the following informalities: the phrase "*computer-readable medium*" in lines 5-6 of **claims 1 and 4**, line 6 of **claims 5 and** 6; and the phrase "*computer-readable information storage portion*" in line 3 of **claim 23**, are not described in the specification.

Appropriate correction is required.

Claim Objections

5. **Claim 23** is objected to because of the following informalities: the term "the information storage portion" in line 9 of the claim, should be changed to --the computer-readable information storage portion--. Appropriate correction is required.

Duplicated Claims Objections

6. **Claim 1** is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 15-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 15 recites "[providing]", "[receiving]", "[searching]" and "[sending]"; and **claim 19** recites "[sending]" and "[receiving]", which are not qualify as a statutory process because the claims do not transform underlying subject matter nor it is tied to

another statutory class. To qualify as a statutory process, the claims should positively recite the other statutory class (e.g. the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state (see MPEP 2106.IV.B and 2106.IV.C; and also see Diamond v. *Diehr*, 450 U.S. at 175, 184 (1981); Gottschalk v. *Benson, 409 U.S. 63, 71 (1972); and also see in re Stephen W. Comiskey, 499 F.3d 1365; 2007 U.S. App. LEXIS 22414; 84 U.S.P.Q.2D (BNA) 1670).*

Claims 16-18 and 20-22 are rejected for the same reason, due to their dependence on the above rejected claims.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Shinohara, US Patent Number 7,310,514.

Regarding claim 1, Shinohara discloses a search device providing a search service about data provided by a contents providing server capable of providing contents, the data provided by the contents providing server corresponding to information showing a capacity of a terminal unit included in an information request command, the search device comprising:

at least one processor that executes computer programs stored on a computer-readable medium (e.g. MMS user database server 30), the computer program including executable code that provides:

a crawling means for searching an address of said contents by using the information showing the capacity of the terminal unit according to a typical model of the terminal unit in a model group, the model group being set according to the capacity (e.g. Based on the information regarding the formats of each media type and the destination information that have been received from mobile telephone 10_1 as well as information that is stored regarding the processing capabilities for each media type for each of mobile telephones 10_1-10_4, MMS user database server 30 first determines whether the multimedia message that is to be transmitted by mobile telephone 10_1can be received at transmission-destination mobile telephones 10_2-10_4, col. 7, lines 1-5);

a search index holding the address of the contents obtained by said crawling means in correspondence to an identifier that identifies the terminal unit in the model group at a time of crawling (e.g. Fig. 4 show an example of data that are registered in MMS user database server); and

a searching means for gobbling down the address of the contents in said search index in correspondence to the identifier included in the information request command from the terminal unit (MMS user database server 30 first determines whether the multimedia message that is to be transmitted by mobile telephone 10_1 can be received at transmission-destination mobile telephones 10_2-10_4; MMS user database server 30 therefore transmits to mobile telephone 10_1 the determination result, col. 7, lines 16-21).

Regarding claim 2, Shinohara further discloses model group is provided per kind of the contents (e.g. Fig. 4).

Regarding claim 3, Shinohara further discloses the search device further comprising:

a template corresponding to every said terminal units of a plurality of generations in which the display capacities of the search results are different (col. 6, lines 1-6);

a generation detecting means for detecting the generation of the terminal unit to which the information request command to said search means is supplied (col. 7, lines 5-9); and

a search result generating means for generating the data of the search result in correspondence to the generation of the terminal unit detected by said generation detecting means (col. 7, lines 9-16).

Claim 4 is similar to claim 1. Therefore claim 4 is rejected by the same reason as set forth in claim 1.

Regarding claim 5, Shinohara discloses an information providing system comprising:

a contents providing server capable of providing contents, the contents provided by the contents providing server including data corresponding to an information showing a capacity of a terminal unit included in an information request command (e.g. MMS user database server 30); and

a search device, coupled to the contents providing server, having at least one processor that executes computer program stored on a computer-readable medium (e.g. the means for determining, col. 13, lines 7-17), the computer program including executable code that provides:

a crawling means for searching an address of said contents by using the information showing the capacity of the terminal unit according to a typical model of the terminal unit in a model group the model group being set according to the capacity (col. 12, lines 66-67-col. 13, lines 1-6);

a search index holding the address of the contents obtained by said crawling means in correspondence to an identifier that identifies the terminal unit in the model group at a time of crawling (e.g. Fig. 4); and

a searching means for gobbling down the address of the contents in said search index in correspondence to the identifier included in the information request command

from the terminal unit (col. 7, lines 16-21).

Regarding claim 6, Shinohara discloses an information searching system comprising:

a contents providing server capable of providing contents, the contents provided by the contents providing server including data corresponding to information showing a capacity of a terminal unit included in an information request command and a key word (e.g. MMS user database server 30 and col. 6, lines 1-6); and

a search device, coupled to the contents providing server, having at least one processor that executes computer programs stored on a computer-readable medium (e.g. the means for determining, col. 13, lines 7-17), the computer programs including executable code that provides:

a crawling means for searching a predetermined address corresponding to said contents by using the information showing the capacity of a typical model of the terminal unit in a model group, the model group being set according to the contents capacity (col. 7, lines 1-5);

a search index holding the predetermined address of the contents obtained by said crawling means in correspondence to a an identifier that identifies the terminal unit in the model group at a time of crawling (e.g. Fig. 4 show an example of data that are registered in MMS user database server);

a searching means for gobbling down the predetermined address in said search index in correspondence to the key word and the identifier included in the information request command from the terminal unit (col. 7, lines 16-21); and

a search result generating means for generating a search result including said predetermined address and the data (col. 7, lines 10-21).

Regarding claim 7, Shinohara discloses, the capacity includes a contents display capacity (Fig. 4).

Regarding claim 8, Rouse discloses, the identifier that identifies the terminal unit is a model name (e.g. mobile telephones 10_1, 10_2, 10_3, 10_4).

Claims 9, 11 and 13 recite "*the capacity*" is similar to claim 7. Therefore claims 9, 11 and 13 are rejected by the same reason.

Claims 10, 12 and 14 recite "*the identifier*" is similar to claim 8. Therefore claims 10, 12 and 14 are rejected by the same reason.

Regarding claim 15, Shinohara discloses a method for providing a search service, comprising:

providing a server that includes data (e.g. MMS user database server 30);

receiving, at the server, a request generated for a requesting device corresponding to the data in the server (e.g. Before transmitting a multimedia message of the above-described format 1, mobile telephone 10_1 notifies MMS user database server 30 of information regarding the formats for each media type of the multimedia message that is to be transmitted and the destination information of the multimedia message, i.e., information indicating that mobile telephones 10_2-10_4 are the destinations, col. 6, lines 61-67);

searching the data in the server according to the capacity information of the requesting device and according to the identification information of the requesting device (col. 7, lines 1-5) ;

sending at least a portion of the data in the server to the requesting device in response to the request, wherein the portion of the data corresponds to the capacity information of the requesting device (e.g. notifies mobile telephone 10.sub.1 of these determination results together with information regarding the formats that can be received by mobile telephone, col.7, lines 9-12).

Regarding claim 16, Shinohara further discloses, the capacity information includes display capacity information of the requesting device (col. 8, lines 27-29).

Regarding claim 17, Shinohara further discloses, the identification information includes a model name of the requesting device (Fig. 4, e.g. mobile telephones 10_1-

10_4).

Regarding claim 18, Shinohara further discloses, the requesting device is a cellular phone (e.g. mobile telephones 10_1).

Regarding claim 19, Shinohara discloses a method for requesting data from a server, comprising:

sending a request generated for a requesting device to the server, wherein the request corresponds to data in the server, and wherein the request includes capacity information of the requesting device and identification information of the requesting device (e.g. mobile telephone 10_1 notifies MMS user database server 30 of information regarding the formats for each media type of the multimedia message that is to be transmitted and the destination information of the multimedia message, i.e., information indicating that mobile telephones 10_2-10_4 are the destinations, col. 6, lines 62-67. Wherein, Each of mobile telephones 10_1-10_4 transmits in any way new information regarding the processing capability for each media type to MMS user database server 30 when an external terminal is connected and the processing capability for each media type changes while the power supply is turned on, col. 6, lines 34-39);

receiving, at the requesting device, at least a portion of the data from the server, wherein the portion of the data corresponds to the capacity information of the requesting device (e.g. MMS user database server 30 therefore transmits to mobile telephone 10.sub.1 the determination result that mobile telephone 10_3 is unable to receive data of

format 2 as well as the information that the only format that mobile telephone 10_3 can receive is format 1, col. 7, lines 16-21).

Claims 20, 21 and 22 recite "*the method*" are similar to claims 16, 17 and 18. Therefore claims 20, 21 and 22 are rejected by the same reason.

Regarding claim 23, Shinohara discloses an information providing server group, comprising:

at least one information providing server (e.g. MMS user database server 30) that includes:

a computer-readable information storage portion that stores information corresponding to a request generated for a requesting device, the request including capacity information of the requesting device and identification information of the requesting device (col. 7, lines 1-5); and

a content server, coupled to the information storage portion, that provides at least a portion of the information to the requesting device in response to the request, wherein the portion of the information provided by the content server varies according to the capacity information of the requesting device and according to the identification information of the requesting device, and wherein the portion of the information provided to the requesting device corresponds to the capacity information of the requesting device (e.g. MMS servers 50_1-50_3, col. 5, lines 59-67).

Claims 24, 25 and 26 recite "*the information providing service group*" are similar to claims 16, 17 and 18. Therefore claims 24, 25 and 26 are rejected by the same reason.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CECILE VO whose telephone number is (571)270-3031. The examiner can normally be reached on Mon - Thu (9AM - 5:00PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on 571-272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 18, 2008

/Cecile Vo/
Examiner
Art Unit 2169

/Tony Mahmoudi/

Supervisory Patent Examiner, Art Unit 2169